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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER HARVEY, DAVID E				
ART UNIT		PAPER NUMBER		
2621				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/525,965

Applicant(s)

URUSHIHARA ET AL.

Examiner

DAVID E. HARVEY

Art Unit

2621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 12/8/2008 and 2/28/2005

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 4 and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A) The preamble of claim 4 indicates that claim 4 is directed to a computer "program" per se. A computer program per se constitutes an abstract idea and therefor constitutes non-statutory subject matter; i.e., a computer program is not a process, machine, manufacture, or composition of matter.

B) The preamble of claim 6 indicates that claim 6 is directed to a computer "program" per se. A computer program per se constitutes an abstract idea and therefor constitutes non-statutory subject matter; i.e., a computer program is not a process, machine, manufacture, or composition of matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) It is noted that the "**if**" terminology recited in line 9 of claim 1 is confusing and indefinite because this recited terminology appears to implicitly encompass the "**if not**" state/condition too (i.e., in which case the limitations that follow the "if" terminology are not required and, for all intents and purposes, simply drop out of the claim). Clarification could be made by changing "**if**" to read **—when—** which requires the recited state/condition to be true at least some of the time.

Similar clarification is required for "**if**" terminology set forth in: line 13 of claim 2; line 16 of claim 2; line 2 of claim 3; line 12 of claim 4; line 6 of claim 5; and line 6 of claim 6.

B) In lines 7-8 of claim 6, "the acquisition process of said content data **by said acquisition means**" (emphasis added) has no antecedent basis and is indefinite because it is not clear as to what the recitation refers. Clarification is needed.

6. The “prior art” of Doi (US Patent #5,179,449) is hereby noted:

Doi has been cited because it evidences:

A) That it was well known in the art to have edited a recorded A/V content by transferring/dubbing only selected portions/scenes of the A/V content to a second recording medium [Note lines 13-30 of column 1]; and

B) That, within such recoding systems, it was known to have provided circuitry for automatically detecting scene boundaries, i.e., “cuts”, in the recorded A/V content thereby enabling the user to locate the portions of the content that are to be selectively dubbed/transferred to the second recording medium [Note lines 10-59 of column 3].

Doi utilizes determined frame-to-frame differences in the recorded A/V content to detect said scene boundaries (i.e., “cuts”).

7. The following “prior art” has been cited because it evidences the fact that it was known in the art to have utilized discontinuities in the sequence of time codes associated with encoded video content to detect scene boundaries (i.e., “cuts”) within video content:

A) U.S. Patent Document # 2001/0048486 to Akama et al.:

SEE: lines 7-14 of paragraph 0088.

B) U.S. Patent Document # 2003/0198463 to Temple et al.:

SEE: paragraphs 0027 and 0032.

In light of the showing of this prior art, the examiner contends that it would have been obvious to one of ordinary skill in the art to have modified conventional video editing systems, i.e., that described in Doi (note paragraph 6 of this Office action), to have detected the scene boundaries (i.e., “cuts”) utilizing detected discontinuities in associated time information as opposed to, or in addition to, determined frame-to-frame differences; i.e., such representing known alternative techniques of determining such boundaries.

8. The "prior art" of Fukai et al. (US Patent #6,546,186) is hereby noted:

Fukai et al. has been cited because it evidences:

A) That it was well known in the art to have edited A/V content recorded by a video camera VTR collecting system (e.g., @ Figures 1A and 1B) using a video editing system (e.g., @ Figure 1C) which functions to transfer/dub selected scenes of the recorded A/V to a second recording medium [Note lines 8-11 of column 4]. The video camera VTR collecting system in Fukai et al. is configured to:

- 1) Associate time codes with the recorded A/V content to aid in the editing process [Note lines 33-38 of column 4]; and
- 2) Associate additional information with the recorded A/V content, e.g., such as information indicative of recording start and stop events, to determined the location of scene boundaries/cuts in the recorded A/V content [Note: lines 50-68 of column 4; lines 1-4 and 14-19 of column 5; and lines 36-48 of column 6].

9. The "combined showing" of Doi et al (U.S. Patent #5,179,449) and Dreier et al (German Patent Document #4,205,762):

A) U.S. Patent #5,179,449 to Doi (see paragraph 6 of this Office action) evidences that it was known in the art to have dubbed a recorded A/V content, i.e., to have selectively transferred the A/V content to a second recording medium, in order to eliminate unwanted A/V content (i.e., commercials) from the recorded A/V content [note lines 11-30 of column 1]. Doi teaches that the beginning and ends of the unwanted content can be determined via processing circuitry which detects scene boundaries/cuts. However, does not describe "the details" as to how such a "dubbing" process is performed based on such detected scene boundaries/cuts of the unwanted A/V content.

B) German patent document #4,205,762 to Dreier et al. is cited because it describes a system by which scene boundaries/cuts, marking the beginning and end of unwanted A/V content, are utilized to selectively stop and start the recording operation of a recording device so that unwanted A/V content is not recorded by the device; i.e., thereby eliminating the unwanted content from the desired A/V content that is recorded by the device [Note: the provided English abstract: and the Figure]. Specifically, the examiner maintains Dreier et al. illustrates "details" of conventional circuitry for performing the dubbing process that was described in Doi for eliminating unwanted A/V content.

10. The following “prior art” has been cited because it evidences the fact that it was well known in the art to have detected and eliminated “gaps”, i.e., non-signal portions, of recorded audio and video content when transferring/dubbing the content to a second recording medium by stopping/pausing the audio/video content during the “gap” periods:

A) Japanese Patent Document # 2000-76736 to Ogawa:

SEE: the provided English abstract; and the system of Figure 1.

B) Japanese Patent Document # 2000-149504 to Miyagawa:

SEE: the provided English abstract; the system of Figure 1; and Figure 5.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Document #2000-76736 to Ogawa.

As is shown in Figures 1 and 2, Ogawa illustrates a dubbing system in which:

1) A predetermined data content (e.g., A of Figure 2), which contains a video content (@ 6 of Figure 2) that separated via non-signal content (e.g., @ 7 of Figure 2), is **acquired**/recorded by an **acquisition means** (e.g., @ 12 of Figure 1) from a predetermined **reproduction device** (e.g., @ 11 of Figure 1);

2) The predetermined content is **monitored** by a "acquisition **stop control means**" (e.g., @ 13, 21, 22) for non-signal areas that separate of reproduced video content (e.g., @ 7 of Figure 2) to generate a "stop control signal" (@ S22 of Figure 1) which controls the **acquisition means** (e.g., @ 12 of Figure 1) **to stop the acquisition**/recording of content during the non-signal periods.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Document #2000-76736 to Ogawa.

A) Ogawa disclosed a system as was set forth above with respect to claim 5;

B) Claim 6 differs from the showing of Ogawa only in that it is directed to a software implementation;

C) The examiner takes Official Notice that it was notoriously well known in the art to have implemented video signal processing systems using programmable processing means in place of dedicated circuitry to obtain many known advantages associated therewith; e.g., easy to update, reduced production cost, etc,...

D) It would have been obvious to one of ordinary skill in the art to have implemented the system shown in Ogawa via software to obtain such advantages.

15. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,170, 449 to Doj in and German Patent Document #4,205,762 to Dreier et al. in view of either one of:

A) U.S. Patent Document #2003/0198463 to Temple et al.; or

B) U.S. Patent Document #2001/0048486 to Akama et al.

I. The showing of Doj:

See paragraphs 6 and 9 of this Office action

II. The showing of Dreier et al.:

A) See paragraph 9 of this Office action;

B) As shown in the Figure, Dreier et al. discloses a system which comprises:

1) Input circuitry (@ 1) for receiving A/V "**content data**" from a **source** (not shown in the Figure), wherein the A/V content data comprises a plurality of different "**access units**" each of which represents one of:

a) Wanted A/V content segments/units; and

b) Unwanted A/V content segments/units;

2) "**Acquisition means**" (e.g., @ 1-4) for acquiring (e.g., for recording) predetermined A/V content (i.e. the access units representing the wanted A/V content/segments); and

3) "**Acquisition stop control means**" (e.g., @ 5) for:

a) "**Monitoring**"/analyzing the received A/V content data to detect the receipt of "access units" pertaining to the unwanted content and, in response thereto, to issue a recording stop/pause command **to stop the acquisition (i.e., recording)** of the received A/V content representing the unwanted access units.

C) It is noted that claim 1 differs from the showing of Dreier et al only in that claim 1:

1) Requires the "source" of the A/V content to be a "reproduction device"; and

- 2) Requires the "monitoring" process to be performed by monitoring the time at which the access unit was recorded so as to detect when a first access unit was recorded earlier than a second access unit.

III. The combined showing of Doi and Dreier et al:

The examiner maintains that it would have been obvious to one of ordinary skill in the art:

- 1) To have implemented the "dubbing" system described in Doi using the circuitry shown/described in Dreier et al given that Dreier et al shows/describes details not addressed in Doi ; i.e., wherein Dreier et al is representative of the "prior art" on which Doi relies for such details; or
- 2) To have configured the system described by Dreier et al for utilization within the "dubbing" environment described by Doi; i.e., wherein Doi is representative of an environment in which such circuitry was known to be utilized.

In either case, the "source" of the A/V content in the modified system is a "reproduction device". However, the modified system monitors the A/V content for scene boundaries via the detection of frame-to-frame differences (e.g., as taught in Doi) as opposed to the detection of discontinuities in time information pertaining to the time of recording.

IV. Obviousness:

A) Temple et al. and Akama et al each evidence that it was known in the art to have monitored time information associated with A/V content for discontinuities thereof in order to determine scene boundaries (i.e., cuts) [See paragraph 7 of this Office action]. The examiner maintains that it would have been obvious to one of ordinary skill in the art to have further modified the modified system of Doi and Dreier et al. in accordance with the teachings of either Temple et al. and Akama et al., whereby the scene boundaries are determined by the detection of such discontinuities in place of, or in addition to, the detection of frame-to-frame differences; e.g., the modification would advantageously provide for more accurate detection of the boundaries. Here, the examiner maintains that the direction of a given detected discontinuity (i.e., which segment was recorded first) has no criticality to the modified system; i.e., the modified system would obviously detect discontinuity either direction).

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16. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #5,170, 449 to Doi and German Patent Document #4,205,762 to Dreier et al. in view of either one of:

A) U.S. Patent Document #2003/0198463 to Temple et al.; or

B) U.S. Patent Document #2001/0048486 to Akama et al.

for the same reasons that were set forth above with respect to claim

1. Additionally:

As noted in the English abstract of Dreier et al., the modified operated under control of a microprocessor which, by definition, run via the execution of a computer program stored on some type of computer readable medium.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Marsha D. Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/

Primary Examiner, Art Unit 2621

DAVID E HARVEY
Primary Examiner
Art Unit 2621